GP2108

PATENT

#7
Zeta
8/8/97

IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

Applicant:

Stephen Temple et al.

Serial No.: 08/536,345

Filed:
September 29, 1995

For: MULTI-CHANNEL ARRAY DROPLET DEPOSITION APPARATUS

Group Art Unit: 2108

Examiner: A. Bobb

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Washington, DC 20231 on this date:

July 11, 1997

James P. Zeller
Reg. No. 28,491
Attorney for Applicants

RESPONSE TO OFFICIAL ACTION AND APPLICANTS' INTERVIEW SUMMARY RECORD

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This paper is in response to the official action of April 14, 1997, in which restriction was required between the claims of Group I (claims 20-33, 46-58, 70, 71, and 74) and those of Group II (claims 34-45, 59-69, 72, and 73), respectively.

The restriction requirement is respectfully traversed on the basis that restriction in this case is inconsistent with prior Office practice, as evidenced by Braun U.S. 5,598,196 (of record), and since any inefficiency resulting from diversity of the respective fields of search for the two groups of claims will be far

outweighed by the potential necessity of conducting interference proceedings involving the Braun patent and two patent applications.

All claims 20-74 pending in this application were added by preliminary amendment. As stated by the examiner, some claims are directed to a method of manufacturing a droplet deposition apparatus (or printhead) while others are directed to the apparatus. Of the pending claims, claims 67-74 (including both method and apparatus claims) correspond directly to claims of Braun U.S. 5,598,196. Should claims 67-74 be prosecuted to allowance in substantially their present form, an interference between the present application and Braun U.S. 5,598,196 would result.

Claims 67-74 include method claims 70, 71, and 74, and apparatus claims 67-69, 72, and 73. Similarly, Braun U.S. 5,598,196 includes apparatus (printhead) claims 1-5 and 9-11, and method claims 6-8, 12, and 13.

Notably, the respective apparatus and method claims of Braun U.S. 5,598,196, which issued January 28, 1997, were prosecuted in the same application without restriction between the respective claims. It is respectfully submitted that given the identity or substantial identity of some of the claims of the present application with those of Braun U.S. 5,598,196, the imposition of the outstanding restriction requirement in this application is directly inconsistent with prior

Office practice, as represented by the prosecution of Braun U.S. 5,598,196.

Furthermore, since present claims 67-74 would be split between two groups pursuant to the outstanding restriction requirement, efficient prosecution of an interference between claims 67-74 and the claims of Braun U.S. 5,598,196 would require the filing of a divisional application including the non-elected claims, with the interference being conducted between the present application, the divisional application, and the Braun patent. Clearly, this procedure would result in delay and inefficient use of the resources of the applicant, the Office, and the owner of the Braun patent.

It is therefore respectfully submitted that any inconvenience or inefficiency resulting from prosecution of the allegedly distinct claims in a single application would be far outweighed by the inefficiencies resulting from prosecution of an interference between an issued patent and two divisional applications.

The foregoing was discussed between the undersigned and Examiner Malley during a telephonic interview conducted May 12, 1997.

Reconsideration and withdrawal of the restriction requirement, and examination of all pending claims 20-74 are respectfully requested.

In the interest of completeness, the applicants hereby provisionally elect the claims of Group II, i.e., claims 34-45, 59-69, 72, and 73, with traverse of the restriction requirement.

Respectfully submitted,

MARSHALL, O'TOOLE, GERSTEIN,
MURRAY & BORUN

July 11, 1997 By _____
James P. Zeller
Reg. No. 28,491

6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6402
(312) 474-6300